

REMARKS

Claims 1-111 are pending and under consideration. Claims 1, 22, 36, 40, 41, 47, 78 and 96 are hereby amended. Claims 2, 48, 81 and 104-111 are hereby cancelled. Claims 112-115 are new. The amendments are not intended to restrict the range of equivalency that may still apply unless so stated herein.

Rejections Under 35 U.S.C. § 102(b)

The Examiner's rejection of Claims 1, 7-9, 22, 36, 40-42, 47, 50-52, 64, 78-80, and 83-85 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,393,057 to Marnell II, ("Marnell") is respectfully traversed for at least the reasons given below.

Marnell discloses a gaming apparatus having a primary gaming device (poker-type game) and a common secondary gaming device (bingo-type game). Col. 3, lines 47-53. The primary game is a standard individual draw poker game coupled to the common secondary game. Col. 3, lines 58-60. The common secondary gaming device is a progressive-type game wherein a plurality of players play against each other to win a progressive jackpot award. Col. 3, lines 51-53. The secondary game has a common matrix of bingo spaces having indicia representing randomly selected winning poker hands which are randomly distributed throughout the matrix. Col. 5, lines 53-55. The indicia include winning poker hands such as Royal Flush (RF), Straight Flush (SF), Four-of-a-Kind (4K), Full House (FH), Flush (FL), Straight (ST), Three-of-a-Kind (3K), Two Pair (2P), and Three Jacks (3-J) as well as hands like Five Jacks (5-J) provided that wild cards are included. Col. 8, lines 53-64. The winning poker hands are randomly distributed in the common bingo matrix outside the control of the players and preferably no two indicia are identical. Col. 5, lines 51-57.

Marnell further discloses that each player plays their individual primary game as a conventional draw poker game. Col. 5, lines 61-63. If a player attains a winning hand in the primary game that matches one of the winning poker indicia of the secondary game, then the player wins that specific bingo space in the common bingo matrix. Col. 8, lines 23-28. The winning space in the secondary game (Fig 2, 66a) is shown by the number of the machine (Fig. 2, 67a) that the winning player is playing. The primary game is repeatedly played and the secondary game is repeatedly updated as players win bingo spaces. Col. 8, lines 65-68. The secondary game is played until a "Bingo" is attained by having filled all five spaces in a roll on a

horizontal, vertical, or diagonal line. Col. 10, lines 7-11. The “Bingo” line can have different players filled in the spaces of the line. Col. 10, lines 7-11. The amount to be paid to the winning Bingo players is weighted or proportional to the value of the poker hand associated with each winning space. Col. 9, lines 24-26. Thus, four-of-a-kind would have a higher payout than two pair in the Bingo game. Col. 9, lines 26-28.

The present invention introduces a new game, gaming machine, and method to operate the same having a *second game of chance* which has the potential for achieving a prize award as described at page 5, lines 20-28. The first and second games of chance are operated in conjunction, but play of the second game is independent of any required event in the first game. The second game of chance has the potential for achieving a prize irrespective of whatever may transpire in the first, or base, game of chance. Thus, the present invention also discloses a gaming machine wherein the player can win the second game of chance without obtaining a win on the primary game of chance. Any prize achieved in the second game is awarded, again irrespective of what happens in the first game. The second game of chance has the potential, on every play, for achieving a prize award. Thus, it is possible for the player to win both the first game of chance and the second game of chance on the first play, or just the second game.

Additionally, and significantly, the present invention teaches that the secondary game of chance is a game in which a *non-monetary prize* is achieved.

The secondary game of Marnell is therefore much different, because what happens in the first game influences what can and cannot be won in the second game. The secondary game of Marnell is *dependent* upon the primary game.

In contrast to Applicants foregoing Claims, the Marnell patent does not disclose or suggest playing a secondary game of chance in conjunction with the first game of chance, wherein operating the second game of chance is irrespective of any final outcome in the first game of chance as recited in independent Claims 36, 40, and 78, (and further in the case of Claim 78, irrespective any event having to occur in the first game to enable the second game). Therefore, these Claims cannot be anticipated by Marnell since Marnell does not disclose each and every element of the claimed invention. Further, Marnell does not include any suggestion to modify the game to arrive at Applicants’ invention. The poker game of Marnell is electronically linked to the bingo game to enable play of the bingo game only upon the occurrence of a winning hand in the poker game. Col. 3, lines 35-40. Furthermore, Marnell teaches it is preferred that a

plurality of game apparatus' is linked together for play of the common bingo game by a plurality of players. Col. 9, lines 49-51. Again, the secondary game of the present invention has no such dependency on any linkage with one, let alone a plurality of primary games.

Applicants' invention further distinguishes over Marnell through the provision of a winning potential on every play of the secondary game. Marnell's "bingo" game requires a progressive build-up. Applicants' secondary game, in contrast, provides potential immediate gratification on the very first play. Independent Claims 1, 41, and 47 now highlight this additional distinction.

For the reasons stated above, Marnell fails to disclose each and every element of the claimed invention concerning Claims 1, 7-9, 22, 36, 40-42, 47, 50-52, 64, 78-80, and 83-85, and does not include any suggestion to modify the game to arrive at Applicants' invention.

The Examiner's rejection of Claims 104 and 110 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,836,817 to Acres ("Acres"). To simplify prosecution of the present application, these claims have been cancelled.

However, in contrast to Applicants foregoing Claims, Acres does not disclose or suggest playing a game of chance on a gaming machine by a player with a player account on a player tracking system wherein certain prizes achieved are credited to the player's account on the player tracking system as recited in independent Claim 104. Therefore, these Claims cannot be anticipated by Acres since Acres does not disclose each and every element of the claimed invention. Further, Acres does not include any suggestion to modify the game to arrive at Applicants' invention. For the reasons stated above, Acres fails to disclose each and every element of the claimed invention concerning Claims 104 and 110, and does not include any suggestion to modify the game to arrive at Applicants' invention. Again, these claims have nonetheless been cancelled to streamline this case for allowance.

In addition, the Claims of the present invention are patentably distinguished from the references included in the Information Disclosure Statement. For example, Bally's "Twin Lightning" is a 2-in-1 game that divides the wager between two games. (See Twin Lightning reference). A center reel scores for both games depending on how the player opted to divide his or her wager between the two games. In contrast, the present invention discloses a secondary game with the potential of achieving only a *non-monetary prize* award and awarding that prize irrespective of the final outcome in the first game of chance.

Rejections Under 35 U.S.C. § 103(a)

The Examiner's rejection of Claims 2-6, 10-20, 37-39, 48-49, 53-62, 65-77, 81-82, and 86-95 under 35 U.S.C. §103(a) as being unpatentable by Marnell is respectfully traversed for at least the reasons given below.

The Marnell patent is described and distinguished above. As noted, the Marnell patent simply does not disclose or suggest the operation of a *secondary game of chance* played in conjunction with, but irrespective of the resolution of the first game of chance, with a *non-monetary* payout; and a chance to win on every play. Since Claims 1, 36, 47, and 78 are allowable for the various reasons above, then Claims 2-6, 10-20, 37-39, 48-49, 53-62, 65-77, 81-82, and 86-95 are also allowable since each is a dependent Claim of an allowable Claim.

The Examiner's rejection of dependant Claims 21, 43, and 63 under 35 U.S.C. §103(a) as being unpatentable over Marnell in view of Acres is respectfully traversed for at least the reasons given below. First, these dependant Claims should be allowable in view of the allowability of their base claims.

Second, in contrast to Applicants foregoing Claims, Marnell and Acres, alone or in combination, do not disclose or suggest playing a first game of chance and playing a secondary game in conjunction with the first game of chance, if enrolled in a player tracking system.

Acres does not provide any of the deficiencies found in Marnell. Acres simply provides, more or less, a teaching of a player tracking system, as noted above. All of the reasons for allowance over Marnell thus also apply to Acres.

Accordingly, for the reasons stated above, Marnell and Acres fail to disclose each and every element of the claimed invention concerning Claims 21, 43 and 63, and there is no suggestion to combine or modify these references to arrive at the presently claimed invention.

The Examiner's rejection of Claims 105-109, and 111 under 35 U.S.C. §103(a) as being unpatentable over Acres is moot in view of their cancellation.

The Examiner's rejection of Claims 44-46 under 35 U.S.C. §103(a) as being unpatentable over Marnell in view of U.S. Patent No. 5,135,224 to Yamamoto ("Yamamoto") is respectfully traversed for at least the reasons given below.

Marnell is described and distinguished above.

Yamamoto discloses a slot-type game machine that utilizes pre-paid cards and a card reader to eliminate the need for coins. Col. 1, lines 50-55; Col. 2, lines 21-24. The player inserts

the pre-paid card into a card reader of the machine to start play of the game. Col.2, lines 25-30. Instead of feeding coins, the player can press the “play” key and the fee for one game is deducted from the credited amount of the prepaid card and the pattern display units start revolving. Col. 2, lines 27-30. When the player presses the “stop” keys for the respective display units at arbitrary times the respective display units stop revolving and a pattern will be displayed on each unit. Col. 2, lines 30-33. If any matches are found, a predetermined number of prize points are added to the score on the display. Col. 4, lines 53-56. If no matched are found, then a predetermined number of prize points are deducted from the score. Col. 4, lines 56-57. The player can resume a game by pressing the “play” key to win or lose his prize points. Col. 4, lines 57-59. When the player wishes to cease playing, he can press the “account” key, whereupon the prize points so far scored are totaled and printed out on a slip of paper by a printer and the prepaid card is returned to the player. Col. 4, lines 60-65. The player can then bring the slip of paper to the prize exchange station to receive his prizes according to his earned points. Col. 4, lines 66-68.

In contrast to Applicants foregoing Claims, Yamamoto, like Acres, does not add anything to Marnell in the way of a secondary game of chance operated in conjunction with the first game of chance, where second game of chance can provide an award on every operation, with only a *non-monetary prize* potentially awardable on every play, as recited in independent claim 41. Since Claim 41 should be allowable for the reasons above, then Claims 44-46 should also be allowable since each is a dependent Claim of an allowable Claim.

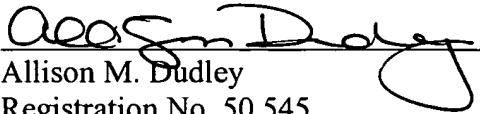
Notwithstanding the non-monetary limitation in the amended claims, new claims 112-115 are patentably distinguished without the non-monetary recitation. Claim 112 recites a first game of chance that is a card game employing a deck of cards and a second game of chance with award indicia assigned to each card of the deck of cards. Claim 113 recites a first game of chance that is a five card poker game and a second game of chance with award indicia associated in a one to one correspondence with a card in the first game of chance. Claim 114 recites a first game of chance that is a slot game with reels having first game indicia. The second game of chance has a plurality of differing award indicia that is displayed through a random selection. Claim 115 recites a first game of chance that is a card game and a second game of chance that has the potential on every play to achieve a prize award. Claims 112-115 are unique, in and of themselves and over the cited references Marnell, Acres and Yamamoto. The cited references do not teach, disclose or suggest each and every element of independent claims 112-115.

Therefore, for at least the foregoing reasons, reconsideration of the rejections is respectfully requested. Allowance of this application is respectfully requested.

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